

DOCKET NO. 13039:90 (CRAN01-00090)

PATENT

#9  
Election  
6.3003



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: : David B. Whitten, et al.  
Serial No. : 09/935,935  
Filed : August 23, 2001  
For : METHOD AND SYSTEM FOR ACCOMPLISHING  
PRODUCT DETECTION  
Group No. : 3651  
Examiner : K.H. Tran

**MAIL STOP NON-FEE AMENDMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**RECEIVED**

JUN 16 2003

**GROUP 3600**

**RESPONSE TO NOTICE OF NON-RESPONSIVE RESTRICTION ELECTION**

In response to the Notice of Non-Responsive Restriction Election mailed May 9, 2003, Applicants respectfully note that the previous response to the Restriction Requirement provisionally elected the claims of Group I, claims 2-15, 34, 36-37 and 44, WITH TRAVERSE. Applicant further provisionally elects Species III.

Applicant believes that claims 2-29, 34-36 and 38-40 and 42-44 read on Species III. Only pending claims 37 and 41 are limited to preventing delivery of "a set" of products if a product delivery is not detected. Moreover, only pending claim 36 is expressly limited to preventing delivery of "all" products if a product is not delivered, such that all remaining claims read on either

preventing delivery of “a set” of products or preventing delivery of “all” products. In addition, regarding the configuration of sensors illustrated variously in Figures 2 and 7, only claim 7 is expressly limited to one of the specific configurations depicted (that of Figure 2). The remaining claims are silent as to the particular physical orientation of the sensors, and thus read on both embodiments.

Applicant maintains traversal of the restriction requirement. Restriction is only proper where the claims are independent or distinct. MPEP § 806, p. 800-39 (8th ed. rev. 1, February 2003). In passing on questions of restriction, the claimed subject matter must be compared in order to determine distinctness and independence. MPEP § 806.01, p. 800-39 (emphasis added). The restriction requirement asserts that the claims of Groups I and II are distinct since “the process claims can be practiced by another materially different apparatus which does not required [sic] the adjustment of the light source from the emitter(s).” Paper No. 6, page 2. However, none of the pending claims includes such a limitation. The restriction is therefore arbitrary and capricious, having no basis in the claims.

In addition, the Restriction Requirement fails to state a factual basis for concluding that “adjustment of the light source from the emitter(s)” would render an apparatus materially different, but instead improperly states only a bald conclusion:

The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.

MPEP § 816, p. 800.56.

Still further, the Restriction Requirement fails to state any basis for asserting the Species I through IV are independent and distinct, and fails to identify characteristics of Figures 2 and 7 upon which the species are asserted to be distinct. Restriction of species must be based on mutually exclusive claim limitations:

Claims to be restricted to different species must be mutually exclusive. The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristics of such species.

MPEP § 806.04(f), p. 800-41. As noted above, only one dependent claim (claim 7) contains a limitation directed to the specific physical orientation of emitter(s) and sensor(s), and only two dependent claims (claims 36-37) are limited to preventing delivery of "a set of products" versus preventing delivery of "all products." The asserted "species" within the Restriction Requirement therefore have no basis in claims 2-29, 34-35 and 38-44.

Still further, the identification of purportedly mutually exclusive species in the Restriction Requirement fails to satisfy applicable restriction practice relating to species:

As pointed out in *Ex parte Ljungstrom*, 1905 C.D. 541, 119 O.G. 2335 (Comm'r Pat. 1905), the particular limitations in the claims and the reasons why such limitations are considered to restrict the claims to a particular disclosed species should be mentioned if necessary to make the requirement clear.

MPEP § 814, p. 800-56. The restriction requirement fails to identify the particular claim limitation(s) relating to the purported species of Figures 2 and 7.

If any issue arises, or if the Examiner has any suggestions for expediting allowance of this

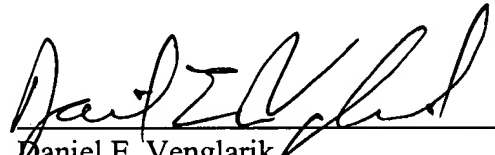
application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *dvenglarik@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: 6-9-03

  
\_\_\_\_\_  
Daniel E. Venglarik  
Registration No. 39,409

P.O. Drawer 800889  
Dallas, Texas 75380  
Phone: (972) 628-3600  
Fax: (972) 628-3616  
E-mail: *dvenglarik@davismunck.com*